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INTELLECTUAL PROPERTY ADMINISTRATION
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EXAMINER
DANNEMAN, PAUL

ART UNIT	PAPER NUMBER
3627	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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DETAILED ACTION

Response to Amendment

1.   This action is in reply to Applicant's response filed on 2 March 2009, to the first office action.

2.   Independent Claims 1 and 18 have been amended.

3.   Claims 1-8 and 18-23 are pending and have been examined in this application.

Response to Arguments

4.   Applicant's arguments filed on 2 March 2009 have been fully considered but they are not persuasive. The arguments are directed to the newly amended claim elements. However, the Applicant argues that the amended claims have new limitations regarding *"dynamically and automatically creating a document profile for the document file based on specific requirements defined at the designer location and particular capabilities of devices at the print service provider location,"* etc. and *"supported of paragraphs [0021 – [0023] of the specification."* The Examiner has closely reviewed the paragraphs cited by the Applicant. The limitations (features) which Applicant has cited consist of the creation of a job ticked with certain default values and selections, the type of print job (brochure, etc.), the number of copies, size of the document in pages, any special finishing instructions, types of binding, packaging instruction, shipping instructions and billing instructions. Also as disclosed in paragraph [0023] the designer is able to use a browser to see what printers and PSPs are available to print and produce the type of job the designer has created. The designer then selects a document profile in order to ensure that the designer created file will properly print at the selected PSP location. The Examiner is unable to find the **"dynamically and automatically creating a document profile…"**

Specification

5.   The amendment filed 2 March 2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter

into the disclosure of the invention. The added material which is not supported by the original disclosure

is as follows: **"dynamically and automatically creating a document profile…"**.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and
process of making and using it, in such full, clear, concise, and exact terms as to enable any
person skilled in the art to which it pertains, or with which it is most nearly connected, to make
and use the same and shall set forth the best mode contemplated by the inventor of carrying out
his invention.

7.   **Claims 1 and 18** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the

written description requirement. The claim(s) contains subject matter which was not described in the

specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s),

at the time the application was filed, had possession of the claimed invention. **"dynamically and**

automatically creating a document profile…".

Claim Rejections - 35 USC § 103

8.   **Claims 1-4, 7 and 18-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Laverty

et al., US 6,791,707 B2, hereafter known as Laverty and 09/480,344 (US 6,633,890 B1) incorporated by

reference.

Claims 1 and 18:

With regard to the limitations:

- *Creating a digital file at a designer location of an image to be printed.*

- *Receiving printer configuration information.*

- *Generating shipping instructions for the printed output.*

- *Creating a file with the digital file and the shipping instructions.*

- *Print and the ship the printed product.*

Laverty in at least FIG. 3, FIG.4 and Column 10, lines 15-67 discloses a series of steps used in

creating a print order. A customer inputs data on the web site and the system creates a Print

Ready File (PRF) and a Print Order. The PRF is shown to the customer for proofing and once

the order is approved the order is sent to the printer along with the customer's order data (i.e.

quantity, shipping address, etc.). Laverty in at least Column 11, lines 1-13 further discloses that

once the order is printed it is shipped to the customer. Therefore, it would have been obvious, at

the time of the invention, to one of ordinary skill in the art that Laverty's customer can be the

designer and subsequently creates the file which will be printed, based on the configuration and

capability of the printer and provides the shipping instructions to the printer.

- *Automatically pre-flighting the digital file at the designer location, automatically*

   checking for common pre-press errors, automatically revising and adding missing

   printing instruction to the received document file;

- ***Automatically providing at the designer location a remote proofing function for a customer of the document file to be printed and automatically tracking the printing of the document file;***
- ***Dynamically and automatically creating a document profile.***

Laverty in at least Fig.39 and Column 7, lines 1-67 and specifically in lines 1-12 discloses a client side application which provides an automated, consistent, error-free and rapid processing of files used in the printing process. Laverty in at least Column 7, lines 13-17 further discloses that proofing is automated and is done through a web site, where PostScript is automatically created, trapped, imposed, and color separated, All of which according to Applicant's specification paragraphs [0003-0006 and 0028] are errors (pre-press common errors). **Secondly**, regarding the ***"automatically adding missing printing instructions"*** as per applicant's specification paragraph [0003], are errors common to composition, imposition, color separation, etc. are steps which traditionally are performed by a "stripper," a knowledgeable person in the pre-press industry who manipulates film directly (Laverty, Column 6, lines 17-25) all of which Laverty solves as disclosed by at least Column 7, lines 13-17 where proofing is automated and is done through a web site, where PostScript is automatically created, trapped, imposed, and color separated.

Laverty in at least Column 10, lines 15-45 discloses the customer going to a custom web site and the web site loads a preconfigured order form **(automatically and dynamically)** for the customer selected product, and the customer enters the data to generate the customer's desired print job. Laverty in at least Column 11, lines 14-23 further discloses details of the Automated Printing System.

Laverty in at least Column 12, lines 29-41 discloses a vendor order system (VOS) which processes tasks or information, including but not limited to, job instructions, purchase orders, invoices, payments, and shipping status of orders. The VOS includes a link to the ILLIAD in order to retrieve various customer related business information. Laverty in at least Column 13, lines 28-42 further discloses that the ILLIAD performs order processing and work-in-progress (WIP) functions.

Claims 2-4 and 19-21:

With regard to the limitations:

- ***Verify and correct the digital file.***

- ***Verify and correct the shipping instructions.***

- ***Supplementing the shipping instructions as required.***

Laverty in at least Column 10, lines 58-67 discloses a customer viewing a file and either approving (or not), changing the digital print file, updating the customer data as required (i.e. quantity, shipping address, etc.). Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill in the art that Laverty allows a customer to proof the print file and update or supplement the shipping instructions as required.

Claims 7 and 22:

With regard to the limitation:

- ***Updating job ticket in the file at the printer service location.***

Laverty in at least FIG.9 and Column 14 lines 44-46 discloses sending a message regarding the success or failure in the performance of a printing task. Laverty in at least Column 12, lines 29-67 discloses a Vendor Order System (VOS) which processes tasks or information, including but not limited to, job instructions, purchase orders, invoices payments and shipping status of orders. Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill in the art that Laverty by messaging the success or failure of a printing task is updating the printer's job ticket.

9. **Claims 5-6, 8 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Laverty and US 6,633,890 B1 as applied to claims 1-2 and 18-19 above, and further in view of FedEx.

Claims 5, 6, 8 and 23:

With regard to the limitations:

- *Sending to the print service provider the operational status of the shipping device.*
- *Sending job status of the shipping device to the print service provider location.*
- *Selecting a shipping device.*

Laverty in at least Column 11, lines 10-11 discloses that an order is shipped to a customer. Laverty in at least Column 12, lines 29-41 discloses a vendor order system (VOS) which processes tasks including job instructions, purchase orders, invoices, payments and shipping status of orders. Laverty in at least FIG.6 and Column 13, lines 43-53 further discloses the system database having billing and shipping rules. Laverty does not specifically disclose the operational status of the shipping device or selecting a shipping device. However, FedEx in at least FedExTrack discloses providing a package tracking service using email for notification and in FedEx Automated Solutions discloses a wealth of electronic tools, applications and APIs for customers to integrate into their processes to shorten response time, reduce inventory costs and simplify their shipping. Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill in the art to combine the elements of Laverty's job and shipping status of orders with the well know FedEx Automated Solutions to achieve the predictable results of providing customers with a shipping solution that meets their needs.

Conclusion

10.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL DANNEMAN whose telephone number is (571)270-1863. The examiner can normally be reached on Mon.-Thurs. 6AM-5PM Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul Danneman/

Examiner, Art Unit 3627

13 April 2009

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627